

Application No.: 10/644,439

Docket No.: 60680-1801

REMARKS

The Office Action dated May 5, 2005 has been carefully reviewed and the Applicant thanks the Examiner for his detailed review of the pending claims. Claim 2 has been cancelled and new claim 11 has been added. Accordingly, claims 1, and 3-11 are pending. Applicant requests reconsideration in view of the following remarks.

I. Claim Rejections Under 35 USC §102(b)

Claims 1, 3, 4 and 6-9 were rejected under 35 U.S.C. §102(b) as being anticipated by Helfman. Claims 1 and 9 were rejected under 35 U.S.C. §102(b) as being anticipated by Hollencamp. Applicant respectfully traverses the rejections.

Applicant respectfully submits that to anticipate a claim, the reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

A. Rejection of Claim 1 Under 35 USC §102(b) in reliance upon Helfman

Applicant notes that independent Claim 1 recites, among other limitations, "a tool for grooving an outer surface of a valve guide, comprising . . . a tightening nut disposed about a portion of the tool body, and a means for rotating the at least one roller about the outer surface of the valve guide, and wherein the tool is capable of providing grooves on the outer surface of the valve guide." Helfman does not disclose a tool that includes a tightening nut disposed about a portion of the tool body. Rather, Helfman teaches a tool for manually reforming and restoring the surface of a cylindrical workpiece, including handles (rods 26 and 27) having a shoulder 28 and 29 and a threaded end in threaded engagement with C-shaped brackets 23 and 24. (Col. 3, lines 26-30). The Examiner suggests that Helfman's operating rods 26 and 27 with shoulders 28 and 29 comprise a tightening nut disposed about a portion of the tool body, as recited by

Application No.: 10/644,439

Docket No.: 60680-1801

Applicant's claim 1. Applicant respectfully submits that operating rods 26 and 27 with shoulders 28 and 29 do not comprise a tightening nut. Rather, rods 26 and 27 with shoulders 28 and 29 are simply handles. While the handles might be capable of securing the brackets onto the workpiece, they are clearly not tightening nuts.

Furthermore, Applicant submits that even if operating rods 26 and 27 were considered tightening nuts, they are not disposed about a portion of the tool body as expressly required by Applicant's claim 1. Rather, operating rods 26 and 27 with shoulders 28 and 29 are merely threaded rods disposed *within* the C-shaped brackets that make a slip fit with the respective brackets and are in threaded engagement therewith. (*Id.*)

Thus, Helfman does not disclose or teach "a tightening nut disposed about a portion of the tool body" as recited by Applicant's claim 1, and accordingly Helfman does not anticipate claim 1. Claims 3-4 and 6-8, which all contain additional limitations to those found in claim 1, depend from allowable claim 1. Accordingly, claims 1, 3-4 and 6-8 are allowable over Helfman. Withdrawal is respectfully requested.

**B. Rejection of Claim 1 Under 35 USC §102(b) in reliance upon Hollencamp**

As stated above, claim 1 recites "a tool for grooving an outer surface of a valve guide, comprising ... a tightening nut disposed about a portion of the tool body ... wherein the tool is capable of providing grooves on the outer surface of the valve guide." The Examiner suggests that Hollencamp discloses a tool "capable of forming a tapered groove on a cylindrical workpiece". Applicant respectfully submits that Hollencamp does not teach making grooves in a workpiece, nor is the Hollencamp reference even capable of forming a groove in a workpiece.

In order to effect a groove in a workpiece, an outermost portion of a tool must necessarily be located within a low point, or a trough, and therefore have material located on either side thereof. After such a groove is made with a tool, the tool must be removed from the workpiece. The material bordering the cutting edge of the tool prevents the workpiece from being pulled directly out of the tool. Thus the removal of the tool can be effected in one of two principal ways. The first way is to have the outermost edge of the tool move away from the workpiece, allowing the workpiece to be removed from the tool unimpeded. Hollencamp

Application No.: 10/644,439

Docket No.: 60680-1801

discloses a tool useful for swaging a workpiece, to effect a substantial reduction in the diameter of the end portion of a cylindrical workpiece. Hollencamp teaches that, despite excessive outward radial pressure applied against the rolls, "the rolls do not become canted or the inner ends of the rolls moved away from the mandrel 13 due to the roll supporting plug 30". (Col. 3, lines 2-5). Hollencamp further teaches that "(t)o prevent inward movement or canting of the swaging rollers from the inner surface of the mandrel sleeve, there is provided a plug member disposed within inner end portions of the rollers". (Col. 1, lines 30-34). Hollencamp thus specifically teaches holding the rollers rigid relative to the mandrel. Therefore Hollencamp cannot be read to allow the rollers to be moved outwardly from the workpiece.

The second principal way of removing a grooved workpiece from the tool is to reverse the direction of the tool, thereby allowing the cutting edge of the tool to travel within the groove as the workpiece is removed. Hollencamp teaches that the tool is set up in such a manner that the "angle of the rollers is such *in respect to the direction of rotation of the tool* that the rollers effect a feeding movement to advance the tool over the end of the workpiece." (Col. 2, lines 40-43; emphasis added). Hollencamp further teaches that when moving the tool in a direction away from the workpiece (i.e. removing the workpiece) "the rollers may cling to the workpiece due to the self-feeding action of the rollers" (Col. 2, lines 55-58). To remedy this, Hollencamp teaches the inclusion of a spring which is compressed when the tool is moved away from the workpiece, such that "the force of the spring will separate the rollers from the workpiece". (Col. 2, lines 59-61). Thus Hollencamp teaches that the tool continues to travel in the same direction, causing the continuation of the self-feeding action, and does not disclose a tool which changes direction to allow the removal of a workpiece.

Based on the foregoing, Applicant submits that Hollencamp does not disclose a tool capable of forming a tapered groove in a workpiece, due to the inability to subsequently remove the tool after forming a groove. Furthermore, even if the invention of Hollencamp were *capable* of forming a groove, Hollencamp does not *teach* doing so, either expressly or inherently. Given that Hollencamp does not teach a tool capable of providing grooves in a workpiece, Applicant's claim 1 cannot be anticipated by Hollencamp under 35 USC §102(b).

Application No.: 10/644,439

Docket No.: 60680-1801

Additionally, the Examiner suggests that Hollencamp discloses a tightening nut (13) disposed about a portion of the tool body. Applicant respectfully submits that the element numbered 13 is not a tightening nut, but is in fact a mandrel having an inner surface threaded for attachment to the external threads 12 of the driver 10. The threaded connection 12 provides for axial adjustment of the mandrel relative to the driver 10. (Col. 1, lines 48-53). Thus mandrel 13 is not useful as a tightening nut. Applicant therefore submits that based on the foregoing, Hollencamp does not anticipate Applicant's claim 1.

Accordingly, Applicant respectfully submits that the rejection of independent claim 1 should be withdrawn and the claim allowed for at least the foregoing reasons.

**C. Rejection of Claim 9 Under 35 USC §102(b) in reliance upon Helfman and Hollencamp**

For at least the foregoing reasons that claim 1 is patentable, independent claim 9 is also patentable over the cited art. Accordingly, each and every limitation of claim 9 is not disclosed or taught by Helfman or Hollencamp. Claim 9 recites, among other limitations, "positioning the grooving tool about a valve guide, tightening a tightening nut disposed about a portion of a tool body of the grooving tool such that at least one roller of the grooving tool engage an outer surface of the valve guide, and loosening the tightening nut such that the at least one roller no longer engages the outer surface of the valve guide...." As stated in the foregoing remarks, neither Helfman nor Hollencamp discloses a tightening nut disposed about a tool body and thus neither can teach "tightening a tightening nut disposed about a portion of a tool body of the grooving tool". Furthermore, as explained above, Hollencamp does not teach a grooving tool. Thirdly, Hollencamp does not teach tightening a portion of the tool body "such that at least one roller of the grooving tool engage an outer surface" of the workpiece. Rather, Hollencamp teaches threading the mandrel 13 upon the driver 10, securing the mandrel thereon with a set screw 14, and subsequently bringing the workpiece into contact with the rollers. Nor does Hollencamp teach "loosening a tightening nut such that the at least one roller no longer engages the outer surface" of the workpiece. Accordingly, as required by 35 U.S.C. §102(b), Helfman and Hollencamp do not teach or disclose each and every limitation of the claimed invention as recited by claim 9.

Application No.: 10/644,439

Docket No.: 60680-1801

Accordingly, the rejection of claim 9 should be withdrawn and the claims allowed for at least the foregoing reasons. Claim 10, which depends from claim 9 is also allowable for at least the above reasons.

**Allowable Subject Matter**

Applicants thank the Examiner for indication of the allowable subject matter of claims 2, 5, and 10. Claim 2 has been re-written in independent form as new claim 11. Claims 5 and 10 remain pending from claims 1 and 9, respectively, which have been shown above to be allowable over the prior art.

**CONCLUSION**

In view of the foregoing remarks, Applicant respectfully submits that the pending application is in condition for allowance. Favorable reconsideration and early allowance are earnestly solicited.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 60680-1801 from which the undersigned is authorized to draw.

Dated: August 5, 2005

Respectfully submitted,

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